

## REMARKS

This amendment is responsive to the Office Action mailed December 18, 2007. Claims 1-20, 22-92, and 98-128 were pending in the application. Claims 1, 22, 112, 117, 122, 127, and 128 have been amended. Claims 129-131 have been added. Thus Claims 1-20, 22-92, and 98-131 are now pending.

### Claim Objection

The Office Action objected to Claim 1 for a minor informality. The feature containing the minor informality has been deleted from Claim 1 and is now presented in Claim 129. The objection is believed to be overcome.

### Rejection Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected Claims 1-92, 98-111, 127, and 128 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant respectfully traverses and submits that the claims meet the requirements of 35 U.S.C. § 112.

The Office Action alleged a lack of clarity of the element "wherein the trial order is not a regular order to buy or sell and does not result in a trade for the item in the order." In particular, the Office Action requested clarification of the terms "regular order" and "trial order" in the context claimed.

Applicant respectfully submits that the specification as filed includes a detailed description of multiple embodiments in which a "trial order" is used and how a trial order is handled differently than a "regular order." For example, a discussion of trial orders and how they are treated by the market and distinguished from regular orders is provided at page 8, lines 20-24; page 27, lines 1-20; and page 114, line 4, to page 115, line 3. The present application includes other references as well that describe trial orders and their use in various

embodiments. See, e.g., the description of FIGURE 70, at page 85, line 9, to page 86, line 4, in particular page 85, lines 17-20 and 25-28.

Applicant thus submits that a person having ordinary skill in the art would understand the meaning of "trial order" and "regular order."

Notwithstanding the above, applicant has amended Claims 1, 127, and 128 to remove references to a "regular order" and focus additional detail on the character and use of a "trial order." In view of these amendments, the rejection of Claims 1, 127, and 128 under 35 U.S.C. § 112, second paragraph, should be withdrawn. For their dependence on Claim 1, the rejection of Claims 2-92 and 98-111 should also be withdrawn.

#### Summary of Prior Art Rejections Alleged in Office Action

Claims 1-18, 20, 22-41, 43-65, 67-81, 86, 89-92, 104-108, and 111-128 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wallman (US 6,601,044). Claims 19 and 66 stand rejected as being unpatentable over Wallman as applied to Claims 15 and 62 in view of Korhammer (US 6,278,982). Claim 42 stands rejected as being unpatentable over Wallman as applied to Claim 40 in view of Minton (US 6,014,643). Claims 82-85 stand rejected as being unpatentable over Wallman as applied to Claim 1 in view of Gutterman (US 5,297,031). Claims 87 and 88 stand rejected as being unpatentable over Wallman in view of Jain (US 6,343,278). Claims 98-103 stand rejected as being unpatentable over Wallman as applied to Claim 1 in view of May (US 6,317,727). Claims 109 and 110 stand rejected as being unpatentable over Wallman in view of "More" (article).

Having reviewed the cited art and the comments provided in the Office Action, and in view of the amendments to Claims 1, 112, 117, 122, 127, and 128, applicant requests withdrawal of the claim rejections and allowance of the application.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

## Patentability of Claim 1

For convenience of examination, amended Claim 1 is repeated, as follows:

1. A method for enabling an order of a user to interact with at least one market process, comprising:
  - configuring a trading process in accordance with the order, wherein the order identifies an item for trading and wherein the order is executable by the market process to complete a trade for the item by pairing the order with a contra-side order of another party,
  - automatically performing, at the trading process, market discovery according to a user-selected discovery strategy selected from a plurality of discovery strategies, wherein the discovery strategies are configured to obtain market information for the item in the order according to different discovery methodologies, and wherein the selected discovery strategy includes automatically sending a trial order to the at least one market process, wherein the trial order identifies an item for trading and a non-zero quantity of the item, and receiving a pairing report from the market process indicating a pairing of the trial order with a contra-side order at a pairing price, wherein upon pairing, the quantity of the item in the trial order is automatically adjusted to zero, the pairing report providing information about current market depth for the item at the pairing price for the non-zero quantity identified in the trial order while the pairing results in an execution of the trial order for a zero quantity of the item, and
  - after performing said market discovery, automatically acting upon the order at the trading process according to a user-selected action strategy selected from a plurality of action strategies based on information obtained from performing the market discovery,
  - wherein the at least one market process and the trading process are computer-implemented software processes.

The disclosure of Wallman does not teach or suggest all of the elements of Claim 1. Wallman provides a system that is directed to help individual or "small" investors define and execute an individual investment portfolio. After the investor's portfolio is defined, the investor can save costs by having trades aggregated with trades of other investors for combined execution. By aggregating one investor's trades with other investors' trades, the system enables an investor to invest a small amount of money (such as \$100 per month, see Col. 20, line 14)

while still achieving the benefits of having risk spread across a portfolio of securities. See Col. 20, line 63, to Col. 21, line 20.

In one aspect, Wallman does not disclose the claim element of "*automatically performing, at the trading process, market discovery according to a user-selected discovery strategy selected from a plurality of discovery strategies, wherein the discovery strategies are configured to obtain market information for the item in the order according to different discovery methodologies.*"

Applicant acknowledges the explanation provided in the Response to Arguments portion of the Office Action (pages 31-32), but respectfully asserts that the explanation is not commensurate with the language of Claim 1. The Office Action quoted Wallman at Col. 30, lines 32-40, but this passage, does not teach "performing . . . market discovery according to a user-selected discovery strategy selected from a plurality of discovery strategies," as claimed. At best, this passage teaches a process of *selecting stocks* for investment. According to Wallman, a user may choose one recommended portfolio over another, but that does not indicate "a user-selected discovery strategy . . . from a plurality of discovery strategies, wherein the discovery strategies are configured to obtain market information for the item in the order according to different discovery methodologies."

Simply stated, specifying a stock selection strategy is not the same as selecting a strategy for performing market discovery. The Office Action (page 32) asserted "[i]t is obvious that if a strategy is chosen by the investor, market discovery would occur." The strategy mentioned is a stock selection strategy, and indeed, while market discovery may occur, nowhere does Wallman suggest that the market discovery occurs according to a user-selected discovery strategy, with the discovery strategies obtaining market information according to different discovery methodologies.

Indeed, the Office Action (page 5) conceded that Wallman does not explicitly state that market discovery is performed. To cure this deficiency, the Office Action suggested "that if an investor would like information on the trading price or a suggested portfolio based on [a] selected strategy as taught by Wallman, that some type of market discovery or research into the price of the security must be performed." Conducting "some type of market discovery" requires conjecture and does not teach or suggest, to the level required by Section 103 to reject a claim, the plurality of discovery strategies "configured to obtain market information for the item in the order according to different discovery methodologies."

Claim 1 further recites "*after performing said market discovery, automatically acting upon the order at the trading process according to a user-selected action strategy selected from a plurality of action strategies*" which is not taught or suggested by Wallman. According to Wallman, after a portfolio is selected, the investor must provide further input to the system to implement the portfolio and place an order for the securities in the portfolio. The Office Action did not address this latter point. Citation of "automatic and expert management" by Wallman does not signify with any degree of specificity that Wallman actually teaches "*after performing said market discovery, automatically acting upon the order at the trading process according to a user-selected action strategy.*"

Claim 1 further recites that "the selected discovery strategy includes automatically sending a trial order to the at least one market process, *wherein the trial order identifies an item for trading and a non-zero quantity of the item, and receiving a pairing report from the market process indicating a pairing of the trial order with a contra-side order at a pairing price, wherein upon pairing, the quantity of the item in the trial order is automatically adjusted to zero, the pairing report providing information about current market depth for the item at the pairing*

*price and the non-zero quantity identified in the trial order while the pairing results in an execution of the trial order for a zero quantity of the item."*

As noted above, in one aspect, discovery may be accomplished according to a discovery methodology by sending a trial order to a market. At a point thereafter, a pairing report for the trial order is received from the market. The pairing report indicating a pairing of the trial order with a contra-side order at a pairing price. However, the trial order does not result in a trade for the item in the order. Instead, upon pairing, the quantity of the item in the trial order is automatically adjusted to zero. Accordingly, the pairing results in an execution of the trial order for a zero quantity of the item. By processing the trial order in this fashion, a user is able to obtain a pairing report that provides information about *current market depth* for the item at the pairing price for the non-zero quantity identified in the trial order.

The Office Action (page 9) noted that, for examination purposes, the feature "wherein the trial order is not a regular order to buy or sell and does not result in a trade for the item in the order" was interpreted to mean that the trial order is a proposed portfolio in the context of Wallman. Applicant disagrees with this interpretation, but nonetheless notes that Claim 1 has been rewritten. Wallman's discussion of proposed portfolios does not read on a trial order as claimed in the present application.

In conclusion, Wallman does not teach or suggest each and every feature of Claim 1, and thus does not support a *prima facie* rejection of Claim 1 under 35 U.S.C. § 103(a). Claim 1 should be allowed.

#### Patentability of Claims 2-20, 22-92, 98-111, and 129

Claims 2-20, 22-92, 98-111, and 129 incorporate all the features of Claim 1 and thus should also be allowed, at least for the same reasons as Claim 1. In addition, applicant submits

that Claims 2-20, 22-92, 98-111, and 129 are also patentable for the additional subject matter they recite, which is not taught or suggested by the prior art.

Extensive detail regarding the patentability of the dependent claims was provided in applicant's response submitted February 5, 2007. Applicant has reviewed the arguments presented in the present Office Action, and remains convinced that the dependent claims present patentable subject matter. The additional disclosures of Korhammer, Gutterman, Jain, May, and the "More" article are unavailing in combination with Wallman to set forth a *prima facie* case of obviousness of dependent Claims 2-20, 22-92, and 98-111.

Claim 129 has been added to present a feature previously claimed in Claim 1. Claim 129 distinguishes over the stock picking process taught by Wallman by reciting the feature "*wherein the trading process is configured with the order, the discovery strategy, and the action strategy prior to automatically performing said market discovery.*" The Office Action alleged that Wallman's process of suggesting stock portfolios constitutes the claimed market discovery. However, according to Claim 129, the trading process is configured with the order, the discovery strategy, and the action strategy prior to automatically performing said market discovery. The Office Action does not explain how Wallman teaches or suggests a trading process that is configured with an order, a discovery strategy, and an action strategy prior to automatically performing said market discovery, as claimed.

Claims 2-20, 22-92, 98-111, and 129 should be allowed.

#### Patentability of Claims 112-126

For convenience of examination, amended Claim 112 is repeated, as follows:

112. A method for enabling multiple orders of a user to interact with at least one market process, comprising:  
configuring multiple trading processes, wherein each trading process is configured in accordance with an order in the user's multiple orders, and wherein each order identifies at least one item for trading;

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

automatically performing, at each trading process, market discovery according to a user-selected discovery strategy selected from a plurality of discovery strategies, wherein the discovery strategies are configured to obtain market information for the item in the order according to a different discovery methodologies, and

automatically acting upon the order at each respective trading process according to a user-selected action strategy selected from a plurality of action strategies,

wherein the at least one market process and the multiple trading processes are software programs that exist independently of each other, are separately executable, and are operative on the same computer platform.

Applicant has studied Wallman (as well as the secondary references of Korhammer, Minton, Gutterman, Jain, May, and "More"), and respectfully submits that Claim 112 is in condition for allowance. The Office Action cited the portfolio asset allocation and alleged multiple and intra-day investment decisions of the investor (Col. 11, lines 25-65; Col. 12, lines 29-42; Col. 25; and Col. 20, lines 59-60 of Wallman) as disclosing the features of Claim 112, but applicant disagrees. Nowhere does Wallman or the other cited art discuss a market process and multiple trading processes that are "software programs that exist independently of each other, are separately executable, and are operative on the same computer platform." Care must be taken to distinguish between a conventional software program that submits data representing orders to a market and trading processes that are each "software programs that exist independently of each other, are separately executable, and are operative on the same computer platform" as the market process. The elements recited in Claim 112 are neither taught nor suggested in the prior art.

Additionally, Claims 113-116 incorporate all the features of Claim 112 and thus should be allowed at least for the same reasons as Claim 112. Claims 113-116 are also patentable for the additional subject matter they recite, which is not taught or suggested by the prior art.

Claims 117-121 are directed to a computing system and are allowable at least for reasons similar to those given above with respect to Claims 112-116. Likewise, Claims 122-126 are



directed to a computer-accessible medium and are allowable at least for reasons similar to those given above with respect to Claims 112-116.

Patentability of Claims 127, 128, 130, and 131

Claims 127 and 128 are respectively directed to a computing system and a computer-accessible medium. The Office Action analyzed these claims similar to Claim 1. For at least the same reasons given above with respect to Claim 1, Claims 127 and 128 are patentable over the prior art. Allowance of Claims 127 and 128 is requested.

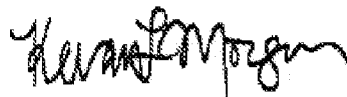
Furthermore, Claims 130 and 131 have been added to present a feature previously claimed in Claims 127 and 128, respectively. As with Claim 129, Claims 130 and 131 distinguish over the stock picking process taught by Wallman by respectively reciting the feature "*wherein the trading processes is configured with the order, the discovery strategy, and the action strategy prior to the discovery component automatically performing said market discovery,*" and "*wherein the instructions, when executed, cause the computer to configure the trading process with the order, the discovery strategy, and the action strategy prior to said instructions causing the computer to automatically perform said market discovery.*" The Office Action does not explain how Wallman teaches or suggests a trading process that is configured with an order, a discovery strategy, and an action strategy prior to automatically performing said market discovery. Accordingly, Claims 130 and 131 should be allowed.

### CONCLUSION

The application is in condition for allowance. Withdrawal of the claim rejections under 35 U.S.C. § 103(a) is respectfully requested. Should any issues remain needing resolution prior to allowance of the application, the Examiner is invited to directly contact the undersigned counsel by telephone.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



Kevan L. Morgan  
Registration No. 42,015  
Direct Dial No. 206.695.1712

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100